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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,265	09/29/1999	ETSUKO KIMURA	Q55939	3838
7590	09/10/2004			
SUGHRUE MION ZINN MACPEAK & SEAS 2100 PENNSYLVANIA AVENUE NW WASHINGTON, DC 200373202			EXAMINER SING, SIMON P	
			ART UNIT 2645	PAPER NUMBER 18

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/408,265

Applicant(s)

KIMURA, ETSUKO

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-6, 9-16, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Schroeder et al. US Patent No. 5,797,098.

1.1 Regarding claims 1 and 11, Schroeder discloses a hand held cellular phone (portable communication device) in figure 1A (column 3, lines 20-23), comprising:

a plurality of soft keys 9 associated one-to-one with a plurality of guide areas of display 11 (Figure 1A; column 3, lines 30-34);

control means (Figure 1B, CONTROLLER 23) for processing selected items in the guide areas when one of said plurality of soft keys next to the guide areas is pressed, such as in figure 11A, operation items "MUTE" and "SCRATCHPAD" corresponds to left and right soft keys 9 are displayed, and when operation item "SCRATCHPAD" is selected by pressing the right soft key 9, CRATCHPAD function is activated or processed (Figure 11B; column 10, lines 22-27); and

wherein, at least one operation item (SCRATCHPAD) selected is displayed hierarchically with at least one operation item (Cancel or Save) currently selectable by a user (Figure 11B; column 10, lines 35-41).

1.2 Regarding claims 2 and 12, Schroeder teaches a handy phone (cellular hone) (column 3, lines 20-23).

1.3 Regarding claims 3 and 13, Schroeder discloses a handheld cellular phone (portable communication device) in figures 1A and 1B (column 3, lines 20-23), comprising:

storing means (ROM 22) for storing a plurality of functions which can be selected by a user;

a display 11 including a plurality of guide areas each for display respective guidance information representative of an operation item which can be selected by the user (Figure 1A; column 3, lines 30-34);

a key input section a plurality of soft keys 9 associated one-to-one with a plurality of guide areas (column 3, lines 30-34);

control means [CONTROLLER 23] for processing selected items in the guide area when one of said plurality of soft keys is pressed, such as in figure 11A, operation items "MUTE" and "SCRATCHPAD" corresponds to left and right soft keys 9 are displayed, and when operation item "SCRATCHPAD" is selected by pressing the right soft key 9, CRATCHPAD function is activated or processed (Figure 11B; column 10, lines 22-27); and

wherein, at least one operation item (SCRATCHPAD) selected is displayed hierarchically with at least one operation item (Cancel or Save) currently selectable by a user (Figure 11B; column 10, lines 35-41).

1.4 Regarding claims 4 and 14, Schroeder teaches that the guide areas comprise a plurality of areas formed by dividing one of a plurality of display lines included in said display, said soft keys are being positioned in the vicinity of said display in a same arrangement as said guide areas (figures 1A, 11A and 11B; column 3, lines 30-34).

1.5 Regarding claims 5 and 15, Schroeder teaches that the guide areas comprise character sequence representative of the operation items, which can be selected by a user (figures 1A, 11A and 11B; column 3, lines 30-34).

Art Unit: 2645

1.6 Regarding claims 6 and 16, Schroeder teaches a handy phone (cellular hone) (column 3, lines 20-23).

1.7 Regarding claims 9, 10, 19 and 20, Schroeder teaches a handy phone (cellular hone) (column 3, lines 20-23).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 8, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al. US Patent No. 5,797,098 in view of Palatsi US Patent No. 5,892,475.

2.1 Regarding claims 7 and 17, Schroeder teaches displaying guidance information in said guidance area, but fails to teach displaying guidance information on other display line of said display.

However, Palatsi discloses a portable electronic device (column 2, lines 18-30) in figures 1-4. Palatse teaches:

a plurality of soft keys 11 and 12 associated one-to-one with a plurality of soft key areas 13 and 14 on a display line included in a display area 8 (Figure 2; column 2, lines 25-27, 34-39);

control means (CPU 5; column 2, lines 19-24) for displaying soft key items (Menu and Fine in figure 2), and processing a selected soft key item in the soft key areas when one of said plurality of soft keys 11 or 12 is pressed (column 2, lines 51-59); and

operation items (On/Off in figure 4, step 26) can be displayed on other display line.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Schroeder's reference with the teaching of Palatsi, so that guidance information would have been displayed on a display line other than the guide areas, because choosing a display line on a display would have been a matter of design choice.

2.2 Regarding claims 8 and 18, Schroeder teaches a handy phone (cellular hone) (column 3, lines 20-23).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



Application/Control Number: 09/408,265  
Art Unit: 2645

Page 8



S.S.

09/01/2004

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